

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Lei Yu

Serial No.: 09/626,616

Filed: July 27, 2000

For: POLYNUCLEOTIDE ENCODING MU
OPIOID RECEPTOR

Group Art Unit: 1647

Examiner: R. Landsman

Attorney Docket. No.: INDA:005USD1/GNS

CERTIFICATE OF MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below:

10/17/01

Date

Gina N. Shishima

DECLARATION OF LEI YU, PH.D.

UNDER 37 C.F.R. § 1.131, REGARDING THE FUKUDA 1994 REFERENCE

I, Lei Yu, hereby declare as follows:

1. I am the inventor of the above-referenced patent application.
2. I understand that the United States Patent and Trademark Office Examiner has found claimed subject matter of the referenced application to be rendered obvious by the reference of Fukuda *et al.*, FEBS Letters, 343:42-46, 1994 (the Fukuda 1994 reference") in view of Fukuda *et al.*, FEBS Letters 327:311-314, 1993 ("the Fukuda 1993 reference"). Claims 44-47 have been rejected over these references.
3. I am submitting this Declaration to set forth that I invented the relevant subject matter of the claimed invention prior to the April 18, 1994 publication of the Fukuda 1994 reference.

4. The Fukuda 1994 reference has been cited as teaching the amino acid sequence of SEQ ID NO:17 of the application. Without conceding the relevance of Fukuda *et al.* to the present claims, I present evidence showing that I had cloned and sequenced cDNA encoding the amino acid SEW ID NO:17 at least as early as the April 18, 1994 publication date of the Fukuda 1994 reference. Attached as Exhibit 1 is a notebook from my laboratory confirming the nucleic acid that corresponds to SEQ ID NO16 and the amino acid sequence (Rat XOR₂), which corresponds to SEQ ID NO:17 of the present application. Dates are redacted. These pages evidence that my lab obtained the relevant sequences at least as early as April 18, 1994, independently of any work in the Fukuda 1994 reference.

5. The work described in Exhibit 1 was conducted in the United States.

6. In view of the above, I invented the claimed subject matter of the present application at least as early as the publication of the Fukuda 1994 reference.

7. Furthermore, the Chen reference should not be prior art against the above-referenced patent application.

8. I hereby declare that all statements made of my own knowledge are true and all statements made on information are believed to be true and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or

imprisonment or both under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any patent issued thereon.

Date: October 17, 2001

Lei Yu
Lei Yu, Ph.D.